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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,042	03/25/2004	Andrew Michael Duggan	CRUI/0012	5804

7590 05/01/2009  
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EXAMINER
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SULLIVAN, DEBRA M

ART UNIT	PAPER NUMBER
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3725

MAIL DATE	DELIVERY MODE
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05/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/809,042	<b>Applicant(s)</b> DUGGAN ET AL.	
	<b>Examiner</b> Debra M. Sullivan	<b>Art Unit</b> 3725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-35,37-71 and 98-100 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,24,26-28,37-41,46-48,50,51,54-62 and 66-70 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-19,22,23,25,29-35,42-44,46,52,53,63-65 and 98-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 5, 2009 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

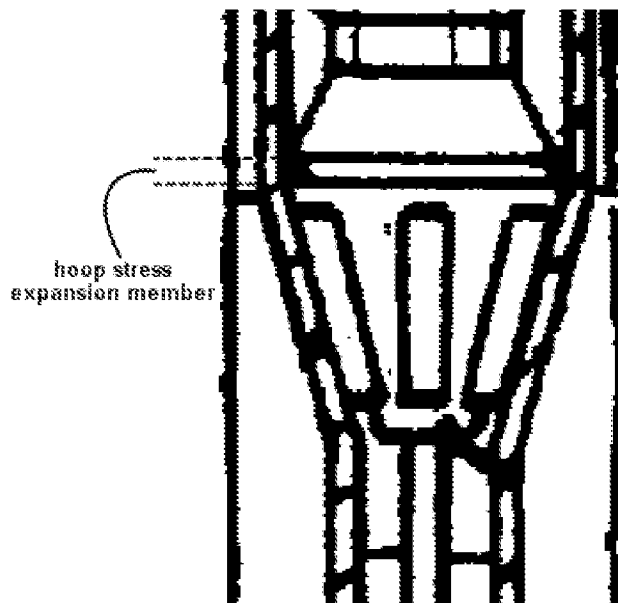
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-19, 22, 23, 25, 29-35, 42, 43, 49, 52, 53, 63-65 and 98-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Metcalfe et al (US Patent # 6,543,552 B1). Metcalfe et al discloses an apparatus for lining a wellbore having an expansion device (20) having expansion members (38) adapted to expand a tubing by inducing a compressive yield and expansion member (See FIG below), comprising of an expansion cone, adapted to expand a tubing by inducing a hoop stress in the tubing such that the compressive yield expansion members (38) expands a tubing (18) to a first diameter and the hoop stress expansion members (See FIG below) expands the tubing to a second larger diameter. Metcalfe et al further discloses the hoop stress and compressive yield (38) are arranged according to the desired post expansion

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diameter in the tubing (18) [See col. 3 lines 6-10] and are spaced alternately in an axial direction and a circumferential direction. The hoop stress inducing expansion member and the compressive yield inducing expansion members (38) are provided on separate portions coupled together wherein a hoop stress inducing tool carries the hoop stress expansion member and the compressive yield inducing tool (30) carries the compressive yield expansion members (38). The hoop stress inducing expansion member is fixed relative to a remainder of the device (20) and are integrally formed with a body of the expansion device (20). The hoop stress members are rotatable with respect to the tubing and rotatably mounted on a body of the device (20). The compressive yield inducing expansion members (38) comprise of a rotary expansion member that rotates about an expansion axis. The compressive yield expansion members (38) are radially movable mounted with respect to the body of the device (20) for movement towards an expansion configuration by applied fluid pressure. The compressive yield inducing expansion members (38) is adapted to expand the tubing (18) by less than 50% or 25% or 10% of the total expansion of the tubing. It is noted that claims 2-4 and 14-19 do not further limit the structure of the expansion device but the disclosure of Metcalfe et al meets the required criteria of the claimed subject matter. [See FIGS 1-3 and col. 5 line 51 – col. 6 line 4].

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe et al (US Patent # 6,543,552 B1) in view of Lauritzen et al (US Patent # 6,722,441 B2). Metcalfe et al disclose the invention substantially as claimed except for wherein the compressive yield expansion member is rotatably mounted on a spindle. However, Lauritzen discloses a compressive yield expansion member (416) rotatably mounted on a spindle (418) to permit rotation about a rotational axis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compressive yield expansion members of Metcalfe et al to be mounted on a spindle in order to permit rotation about a rotational axis.

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***Response to Amendment***

The declaration under 37 CFR 1.132 filed March 5, 2009 is insufficient to overcome the rejection of claims 1 and 100 based upon Metcalfe et al applied under 35 USC 102 as set forth in the last Office action because: the declaration fails to provide factual evidence to support the statement that the designated portion in figure A does not expand the tubing by inducing hoop stress.

***Allowable Subject Matter***

Claim 45 is allowed, please refer to the office action dated January 24, 2008 for the reasons for allowance.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Sullivan whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 10am - 8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached at (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Debra M Sullivan/  
Examiner, Art Unit 3725

/Dana Ross/  
Supervisory Patent Examiner, Art Unit 3725